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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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29177 7590 11/16/2007 BELL, BOYD & LLOYD, LLP P.O. BOX 1135 CHICAGO, IL 60690			EXAMINER VAN HANDEL, MICHAEL P	
			ART UNIT 2623	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/963,981

Applicant(s)

BAESE ET AL.

Examiner

Michael Van Handel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an Amendment filed 9/05/2007. Claims 1-14 are pending. Claims 1, 2, 8, 11 are amended. The examiner hereby withdraws the objection to claim 8 in light of the amendment.

Response to Arguments

1. Applicant's arguments regarding claims 1, 10, and 11, filed 9/05/2007, have been fully considered, but they are not persuasive.

Regarding claims 1 and 11, the applicant argues that Sharma fails to disclose that the contents displayed on the mobile device are for continuous display. The examiner respectfully disagrees. The applicant specifically argues that Sharma discloses displaying a single page of data until refreshed by the user or periodically, but does not continuously display data.

Sharma discloses a communication system and method for communicating teletext information to mobile stations. A wireless access protocol (WAP) server is coupled to a television station and receives a signal, which includes teletext information from the station. The WAP server controller receives information requests from a network interface coupled to the mobile stations and transmits the information to the mobile station through the network interface (see Abstract). The teletext message is then displayed at the mobile station as it is being transmitted (col. 2, l. 65-67). Sharma further discloses that the WAP server can "push" new information without a subscriber request to the base station 106, which transmits the data to the

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mobile station 112 via a radio link for display (col. 4, l. 27-33). The examiner interprets this as “transmitting the data which represents textual contents of the related television program from a transmitter to a mobile terminal for continuous display,” as currently claimed.

In an alternative interpretation, Sharma discloses displaying particular teletext pages in response to user requests (col. 5, l. 41-53; col. 7, l. 15-16; & Figs. 5A-5E). Each page is transmitted in response to a user request, as illustrated in Figure 6 (Fig. 6). A user can use the “Back” option to return to previously viewed pages or may skip to pages of interest by directly entering page numbers (col. 7, l. 18-23). Since the page data is displayed until the user requests another page or requests a previously accessed page, the examiner interprets this as transmitting data ... to a mobile terminal for continuous display. The applicant seems to imply that the claimed invention requires the displayed data to be continuously updated and changed without user interaction; however, this is not recited in the claims. Furthermore, Applicant’s specification describes either displaying the transmitted information continuously on-line on a display on the terminal or storing the transmitted information in the terminal (p. 5, lines 12-14). The examiner fails to find any indication in Applicant’s specification that the display be continuously updated (in real-time, for example). As such, the examiner interprets the continuous display of any of screens 5B, 5C, or 5E as meeting the claimed limitation. Furthermore, Sharma discloses that the mobile station may be configured to update page contents on a user configured periodic basis (col. 7, l. 24-35). This also meets the claimed limitation.

Referring to claim 10, the applicant argues that the display of the selected device does not at least partially represent textual contents of the television program, as required by the claim. The examiner respectfully disagrees. The applicant specifically argues that, in Marshall et al.,

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the racing data is textual data that relates to a wager being made on the television program being viewed, but it not data about the television program itself.

Marshall et al. discloses an interactive wagering system that promotes wagering to users at user equipment, which could be a set-top box and television, a cellular phone with a display, etc. Wagering may be promoted by notifying the user of an opportunity to place a wager on a given race (see Abstract & col. 5, l. 1-4). Wagering information may be provided to a user terminal in connection with wagering-related television broadcasts (col. 2, l. 33-34). Marshall et al. discloses that any known arrangement for providing the wagering information with the television may be used (col. 48-49), and that the manner by which the wagering information relating to the television broadcast is provided may be selected in part on the particular hardware platform on which the wagering interface is implemented (col. 2, l. 55-58). Marshall et al. further discloses that racing data and other information for the interactive wagering service may be provided to cellular telephones in the form of alphanumeric messages (col. 14, l. 51-65). For example, a user may place a wager using a cellular telephone while driving home, and may determine the outcome of the wager when home by watching a video of the race on user television equipment (col. 17, l. 23-28). Racing data may include such statistical data as the post times for each race, jockey names, runner names and the number of races associated with each track, etc. (col. 7, l. 31-37). Since the race is being broadcast on a wagering television channel broadcast or a conventional television channel broadcast, the examiner interprets this data as "data which at least partially represents textual contents of the television program," as currently claimed.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claim 2, the amended claim recites a “step of storing at least one video recording of the television program upon reception of the radio transmitted data.” The applicant’s specification recites that “the transmitted data may be stored in a memory device 12 prior to transmission” and that “the television program for which the data relates can be stored in a memory device 11 (p. 5, l. 7-9);” however, the examiner notes that each of these memory devices are located at the television organization and are used to store data prior to transmission. The examiner fails to find any mention of recording a television program upon reception of the radio-transmitted data and further fails to find any mention of storing a video recording of a television program on the mobile terminal.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5-7, 9, 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Sharma.

Referring to claims 1 and 9, Sharma discloses a method of transmitting data which represents contents of a related television program that is being concurrently broadcast comprising the steps of radio transmitting the data which represents textual contents of the related television program from a transmitter to a mobile terminal for continuous display (the examiner notes that teletext messages are decoded from television signals and transmitted to mobile stations 112. Telephonic communication is effectuated between the mobile station and the WAP server 102. A user can refresh a teletext page containing the latest score of a soccer match, thereby transmitting data which represents contents of a related television program that is being concurrently broadcast, as claimed)(col. 3, l. 64-67; col. 4, l. 1-36, 48-54; col. 5, l. 14-53; col. 7, l. 26-28; & Fig. 1).

Referring to claim 5, Sharma discloses a method as claimed in claim 1, further comprising the step of storing pre-selected television program information in memory (col. 5, l. 63-67 & col. 6, l. 1-5), and wherein the transmitting step further comprises transmitting the stored pre-selected television program information (col. 4, l. 17-36).

Referring to claim 6, Sharma discloses a method as claimed in claim 5, wherein the transmitting step further comprises transmitting the stored pre-selected television program information by one of automatically, according to a predetermined schedule, on request, and combinations thereof (col. 4, l. 17-36; col. 5, l. 20-23; & col. 7, l. 24-35).

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NOTE: The USPTO considers the applicant's "one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim 7, Sharma discloses a method as claimed in claim 1, further comprising the step of matching a form of the data to display options of the mobile terminal (col. 5, l. 30-53; col. 6, l. 9-16).

Referring to claim 11, Sharma discloses an apparatus for transmitting data, which at least partially represents contents of a television program to a mobile terminal, comprising:

- a device having a television program (col. 5, l. 63);
- a device having data, which at least partially represents textual contents of the television program (col. 5, l. 63-67 & col. 6, l. 1-5); and
- a transmitter connected to the device having the television program and the device having data, which at least represents contents of the television program, the transmitter transmitting the data via a mobile radio network to the mobile terminal concurrently with a broadcast of the television program for continuous display (col. 4, l. 17-36, 48-54 & col. 6, l. 6-23).

Referring to claim 12, Sharma discloses an apparatus according to claim 11, wherein the device having a television program further comprises one of a device having a live television program (the examiner notes that it is inherent for the WAP server to have a live television program in order to provide the latest score of a soccer match)(col. 7, l. 23-28), a memory, which stores a recorded television program, and combinations thereof.

NOTE: The USPTO considers the applicant's "one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

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Referring to claims **13** and **14**, Sharma discloses an apparatus according to claims **11** and **12**, respectively, wherein the device having data, which at least partially represents contents of the television program, further comprises one of a device having on-line generated data (col. 7, l. 24-35), a memory, which stores the data (col. 5, l. 63-67 & col. 6, l. 1-5), and combinations thereof.

NOTE: The USPTO considers the applicant's "one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

3. Claim **10** is rejected under 35 U.S.C. 102(e) as being anticipated by Marshall et al.

Referring to claim **10**, Marshall et al. discloses an apparatus for transmitting data, which at least partially represents contents of a television program to a mobile terminal, comprising:

- a television program memory device capable of storing the television program (the examiner notes that the transaction processing and subscription management system 24 can record racing videos)(col. 13, l. 32-57);
- a data memory device having the data, which at least partially represents textual contents of the television program (col. 7, l. 2-5; col. 14, l. 51-67; & col. 15, l. 1-10); and
- a transmitter device connected to the television program memory device and the data memory device, the transmitter device transmitting the data via a mobile radio network to the mobile terminal concurrently with broadcast of the television program (col. 13, l. 35-36; col. 14, l. 51-67; & col. 15, l. 1-10).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma in view of Wegener et al.

Referring to claims 2 and 4, Sharma discloses the method as claimed in claim 1. Sharma does not disclose a step of storing at least one video recording of the television program upon reception of the radio transmitted data or transmitting video data which represents contents of the television program. Wegener et al. discloses transmitting video content to a cellular telephone and storing the video content in the cellular telephone's memory (col. 3, l. 46-48; col. 5, l. 14-60; & Fig. 1). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Sharma to include transmitting and storing video content on a cellular phone, such as that taught by Wegener et al. in order to quickly provide a user with additional multimedia content.

3. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma in view of Wegener et al. and further in view of Sladek et al.

Referring to claim 3, the combination of Sharma and Wegener et al. teaches the method as claimed in claim 2. The combination of Sharma and Wegener et al. does not teach that the transmitting step further comprises transmitting additional data related to the television program

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via short message service (SMS). Sladek et al. discloses sending an SMS message indicating a television station that is being watched to a cellular phone (col. 4, l. 4-6; col. 5, l. 46-50; & col. 16, l. 14-17). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the combination of Sharma and Wegener et al. to include sending an SMS message indicating a television station that is being watched to the cellular telephone, such as that taught by Sladek et al. in order to provide a user with useful informational updates.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma in view of Youngs et al.

Referring to claim 8, Sharma discloses a method as claimed in claim 1. Sharma further discloses a mobile switching center (MSC)(col. 4, l. 42-54). Sharma does not disclose a step of automatically billing costs for the transmission via a telephone bill for the user of the mobile telephone. Youngs et al. discloses a Mobile Switching Center (MSC) 22, which compiles mobile billing information (col. 2, l. 27-30). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the MSC of Sharma to compile mobile billing information, such as that taught by Youngs et al. in order to appropriately compensate network and content providers for the usage of their products/services.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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